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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,923	08/07/2001	Martin Hintermann	01-488	1870

7590 01/28/2004  
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EXAMINER

GUARRIELLO, JOHN J

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

# Office Action Summary

Application No.

09/890,923

Applicant(s)

HINTERMANN, MARTIN

Examiner

John J. Guarriello

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-32 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

1. The Examiner acknowledges the response of 9/26/2003.

This response cancelled original claims 1-14, and added new claims 15-32.

Applicant's arguments regarding the previous rejection of record were considered, but with the new grounds of rejection these arguments are moot.

#### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: line 5, term "marital" appears to be a typographical error, it appears the term should be **material**. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 835 741 in view of Steibel et al. 6,280,550.

EP 835 741 describes a fibre reinforced composite, (see abstract). It is the Examiner's position that the claimed invention is directed to a staple

fibre reinforced moulded part made of a hybrid yarn with thermoplastic material and inorganic material which moulded part comprises a matrix of thermoplastic fibers embedded with oriented fibers of an inorganic material. The claim is directed to a product-by-process analysis. EP'741 describes the shaping of the article can be carried out before, after, or simultaneously with impregnation (which corresponds to the claimed embedding), (see abstract). EP'741 describes the shaping and heating and forming steps ( which correspond to the claimed method steps) so that the moulded article can be formed, (page 3, column 3, lines 49-58). EP'741 describes the matrix material can be provided in the form of fibres or filaments together with the reinforcement fibers, (page 3, column 4, lines 25-34). EP'741 describes the reinforcement fibers can be other forms of reinforcement besides staple fibers, (page 2, column 2, lines 18-23). EP'741 differs from the claimed invention because it is silent about other kinds of specific inorganic reinforcement fibers, (column 2, line 23, page 2).

Steibel describes composite articles with reinforcement fibers of silicon carbide,(corresponding to the claimed inorganic material of fibers) (see abstract). Steibel describes the silicon carbide may be unidirectional , (column 3, lines 39-41), (corresponding to the claimed oriented fibers of

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inorganic material) or otherwise needed as the appropriate article needed to be moulded or formed, (column 3, lines 45-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the silicon carbide fibers (corresponding to the claimed inorganic fibers) of Steibel in the matrix of EP'741 motivated with the expectation that an improved article would result with better strength. Regarding the length of the fibers the ideal length will depend upon the dimensions of the article produced and would be obvious to one of ordinary skill in the art to optimize. Regarding amounts of volume of the first thermoplastic material and the amounts of volume of the second inorganic material this too would be optimized by one of ordinary skill as noted in EP'741 for both considerations, (page 4, column 5, lines 29-50; page 3, column 4, lines 8-33). Furthermore, it is the Examiner's position that even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or is obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process, see *In re Thorpe*, 227

USPQ 964 (Fed. Cir. 1985). The burden is shifted to applicant to show the unobvious differences between the claimed product and the prior art product, see *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983)

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 571-272-1476. The examiner can normally be reached on 8 hr. flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.



John J. Guarriello  
Patent Examiner  
Art Unit 1771

January 15, 2004



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
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